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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,612	11/13/2001	James D. Ralph	337562000901	1151

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EXAMINER

REIP, DAVID OWEN

ART UNIT

PAPER NUMBER

3731

DATE MAILED: 05/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/992,612

Applicant(s)

RALPH ET AL.

Examiner

David O. Reip

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-47 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 12-47 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

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DETAILED ACTION

Reissue Applications

The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following: The error which is relied upon to support the instant reissue application, specifically the error with respect to claim 1, is not an error upon which the instant reissue can be based, because claim 1 has been cancelled by preliminary amendment. See 37 CFR 1.175(a)(1) and MPEP § 1414.

Further, reissue oath/declaration filed with this application is defective because the oath/declaration fails to reference the preliminary amendments filed 1/13/01 and 1/28/03.

Claims 12-47 are rejected as being based upon a defective reissue oath/declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the oath/declaration is set forth in the discussion above in this Office action.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, an embodiment of the locking collar having a slot that extends the entire length of the collar, rendering the collar an incomplete circle, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

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A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 37 is objected to because of the following informalities: in line 12, the second occurrence of the phrase "to the" appears to be a typographical error. Appropriate correction is required.

Specification

The disclosure is objected to because of the following informalities: The continuing data portion of the specification has not been amended to include a cross reference to the parent reissue application 09/774,915, filed 01/30/01, now REI 37,665. See MPEP 1451.

Appropriate correction is required.

The amendment filed 1/28/03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: an embodiment of the locking collar as recited in claim 44, "wherein said locking collar slot extends the entire length of the collar, thereby rendering the collar an incomplete circle."

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Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 44 and 47 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification contains no disclosure or illustration of a locking collar with a slot extending the entire length of the collar and thus forming an incomplete circle as recited. Therefore, such an embodiment is not enabled by the disclosure.

Claims 44 and 47 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no indication in the disclosure that the applicant has possession of an embodiment of the locking collar with a slot extending the entire length of the collar and thus forming an incomplete circle.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 20-23 and 29-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 20 is unclear in that lines 16-22 seem to indicate that ***theadably advancing*** the threaded upper socket portion 142 in the upper threaded portion 216 of the receiving member 204 causes compression of the lower curvate surface (of the fixation element 120) against the interior surface of the lower socket portion 132, thereby causing the upper and lower socket portions, the semi-spherical head of the fixation element, and the receiving member to be locked relative to one another. As understood from the disclosure, the compression and final relative locking of the socket portion, fixation element, and receiving member is caused by threading the locking nut 185 onto the upper threaded portion 216 of the receiving member, which in turn bears against the rod 250, driving the rod downward against the cap portion 142, which in turn drives the lower socket portion 132 into the tapered lower chamber 203, resulting in compression of the lower socket portion about the semi-spherical head of the fixation element and the final locking of components.

Claims 29 and 30 are unclear due to the same issue as discussed above.

Further, in claim 29, line 2, "the force" lacks antecedent basis in the claims.

Clarification by explanation and/or amendment is required.

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Note to applicant: The instant application is a continuation of reissue application Ser. No. 09/774,915, effectively filed 1/2/98, now US RE37,665, which is a reissue of U.S. Pat. No. 5,882,350, filed 1/2/98, which is a CIP application Ser. No. 08/663,383, filed 6/13/96, now U.S. Pat. No. 5,669,911, which is a CIP of application Ser. No. 08/421,087, filed 4/13/95, now U.S. Pat. No. 5,520,690. An analysis was conducted to determine which (if any) of the newly presented claims in the instant continuation application could be fully supported by the disclosures of the earlier '911 and '690 patents, in order to determine the effective filing date of each of the claims and thus be able to determine which (if any) patents or other publications constituted prior art. The analysis concluded the following:

Claims that are not supported in either of patents '911 or '690 = 12-15 and 18-36.

Thus, **claims 12-15 and 18-36 have an effective filing date of 1/2/98.**

Claims that are supported in patent '911 only = 16-17 and 43-47.

Thus, **claims 16-17 and 43-74 have an effective filing date of 6/13/96.**

Claims that are supported in both patents '911 and '690 = 37-38 and 40-42.

Thus, **claims 37-38 and 40-42 have an effective filing date of 4/13/95.**

Claim that is not supported in the '911 patent, but is supported in the '690 patent = 39.

Thus, because there is a break in the chain of support for claim 39 from the '350 patent to the '690 patent, **claim 39 has an effective filing date of 1/2/98.**

In view of the above analysis, the following rejections are set forth:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Errico et al (U.S. Pat. No. 5,531,746). Figs. 4, 5a and 6 of Errico et al show an orthopedic device having all the limitations as recited in claims, including: a screw 120 having a semi-spherical head 122, a threaded shaft, and a tool recess 130; a coupling element 142 having an axial hole 138 extending therethrough, a portion of the axial hole defining an interior volume 140 for receiving the semi-spherical head of the screw, the coupling element further including at least one slot 146 rendering the interior volume deformable and a tapered exterior surface; a receiving member 100 including a through hole having an interior wall surface 111, a portion of the interior wall surface of the through hole being shaped to receive the coupling element and the screw when the semi-spherical head of the screw is mounted within the coupling element; wherein advancement of the screw through the through hole relative to the receiving member

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when the exterior surface of the coupling element engages the interior wall surface of the through hole prevents the coupling element from further advancement through the hole, preventing the semi-spherical head of the screw from advancing further through the through hole, and causing locking of the screw relative to both the coupling element and to the receiving member thereby locking the angle of the screw relative to the axial hole.

Claims 12, 13, 16, 17, 20-22, 24-30, 43, 45, and 46 are rejected under 35 U.S.C. 102(e) as being anticipated by Biedermann et al (U.S. Pat. No. 5,672,176). Figs. 1-3 of Biedermann et al show an orthopedic device having all the limitations as recited in claims 12, 13, 16, 17, 20-22, 24-30, 43, 45, and 46, including: a screw 1 having a semi-spherical head 3, a threaded shaft 2, and a tool recess 4; a coupling element 20 (alternatively the "lower socket portion," the "second intervening member," or the "locking collar") having an axial hole 27 extending therethrough, a portion of the axial hole defining an interior volume 25 for receiving the screw head, the coupling element further including at least one slot 28 rendering the interior volume deformable, a tapered exterior surface 24, interior threads (or "conformations") 13; a threaded "upper socket portion" 45 (alternatively the "first intervening member"); and a receiving member 5 (alternatively a "rod coupling member") including a through hole having an interior wall surface 16, a portion of the interior wall surface of the through hole being shaped (tapered) to receive the coupling element and the screw when the semi-spherical head of the screw is mounted within the coupling element.

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Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 12-47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. RE37,665.

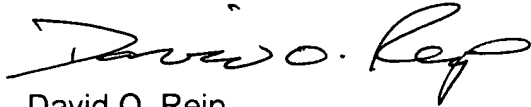
Although the conflicting claims are not identical, they are not patentably distinct from each other because in various ways, the patent claims are overall narrower and therefore constitute "species" of invention as compared to the overall broader "generic" claims of the instant application. Thus, the generic invention is "anticipated" by the species of the patented invention. Accordingly, absent a terminal disclaimer, claims 12-47 are properly rejected under the doctrine of obviousness-type double patenting. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David O. Reip at (703) 308-3383. The examiner can normally be reached Mon-Thu and every other Fri from 7:00 AM to 4:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano, can be reached at (703) 308-2496. The fax number for this Unit is (703) 308-2708 (unofficial) or (703) 872-9302 (official). The examiner can also receive direct-to-computer faxes at 703-746-3310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist at (703) 308-0858.

A handwritten signature in black ink, appearing to read "David O. Reip". The signature is fluid and cursive, with a large initial "D" and a stylized "R".

David O. Reip
Primary Examiner
April 29, 2003